

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Leonard Marchese Conf. No.: 1815  
Serial No.: 09/613,980 Art Unit: 2151  
Filed: July 11, 2000 Examiner: Khanh Dinh  
For: ELECTRONIC SPACE AND METHOD FOR PROVIDING  
RESOURCES TO FACILITATE IDEATION  
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Office Of Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR 1.181(a)(1)**

Sir:

The Applicant in the above referenced matter hereby petitions the Commissioner under 37 CFR 1.181 (a)(1) to withdraw the “Notice of Non-Compliance with the Requirements of 37 CFR 41.37” mailed December 31, 2007 in the above referenced matter, enclosed as Exhibit A. Such a Notice is not subject to appeal to the Board of Patent Appeals and Interferences, and this petition is authorized pursuant to MPEP 1205.03.

**Statement of Facts**

The Final Rejection in this case issued on October 7, 2004, with a Notice of Appeal timely filed thereafter, followed by an Appeal Brief submitted on May 4, 2005. On August 26, 2005, instead of an Examiners' Answer, the Examiner issued an Office Action, citing new grounds for rejection. On January 26, 2006, the applicant requested reinstatement of the appeal, and submitted a revised appeal brief addressing the new grounds for rejection. Nearly two years later, on September 14, 2007, the Examiner issued a notice of non-compliance relative to the

Summary of Claimed Subject Matter, to which the applicant filed a reply on September 28, 2007. A copy is enclosed as Exhibit B hereto.

Now, yet again, the Examiner has issued yet another notice of Non-Compliance, this time the stated reason is "The explanation of the subject matter in independent claims (21, 26 and 32) should be defined in separate sections."

No such requirement is incorporated in the rules governing appeal briefs.

The Appeal Brief as presently submitted is in full compliance with the requirements of 37 CFR 41.37.

#### Argument

The Applicant believes the Examiner has improperly deemed the Appeal Brief to be in non-compliance with 37 CFR 41.37(c)(1)(v). The Brief does contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, with reference to the specification by page and line number and to the drawings. There is no requirement that there be separate sections devoted to each independent claim, and as no such requirement exists, that cannot be a basis for rejecting the appeal brief. It certainly pushes form over substance to use minutia totally unrelated to the patentability of claims to delay and defer a full and fair hearing of an applicants' claims on appeal. Too often, these notices issue not as to any real substance but as a tool to subvert the applicants' right to contest the rejection of his claims before the Board of Appeals.

The Appeal Brief as originally filed on May 4, 2005 was not deemed non-compliant, and contained a nearly identical "Summary of the Claimed Subject Matter", and then it took nearly two years to issue the first Notice of Non-Compliance. Now, a second Notice issues directed to the style, not the substance of the Brief.

The subject section is called a "Summary" for a reason; it need only be a brief, and concise explanation, because the application and drawing are of record in the Appeal. What was submitted met the requirements for a proper appeal brief and the examiner has no right to create new and individual requirement for how they would like to see an appeal brief prepared. An examiner cannot impose his own individual preferences on Appeal Brief preparation; that is not the rule, they must only assure compliance with the Rules of Procedure, and no more.

Because the Examiner improperly issued the Notice of Non-Compliance for reasons beyond the scope of a proper review as to form, the applicant hereby petitions the commissioner to withdraw the Notice of Non-Compliance, and the applicant respectfully requests that the Petition be granted, and the Notice of Non Compliance mailed on December 31, 2007 be withdrawn.

To the extent a fee is required for this Petition, the undersigned hereby authorizes the Commissioner to charge the petition fee to deposit account no. 04-0838.

Respectfully submitted,

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**Bridgeport, CT 06605**  
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\_\_\_\_\_/WJS/\_\_\_\_\_  
 William J. Sapone  
 Registration No. 32,518  
 Attorney for Applicant(s)

# EXHIBIT A



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,980	07/11/2000	Leonard E. Marchese	11590/9-1268	1815

7590 12/31/2007

William J SaponE, (REG. NO. 32,518)  
COLEMAN SUDOL SAPONE, P.C.  
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BRIDGEPORT,, CT 06605-1601

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/31/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
JAN 8 2 2008  
COLEMAN SUDOL SAPONE, P.C

**Notification of Non-Compliant Appeal Brief  
(37 CFR 41.37)**

Application No.

09/613,980

Applicant(s)

MARCHESE, LEONARD E.

Examiner

Khanh Dinh

Art Unit

2151

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 28 September 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.  
**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

The explanation of the subject matter in independent claims (21, 26 and 32) should be defined in separate sections.

*Khanh Dinh*

Khanh Dinh  
Primary Examiner  
Art Unit: 2151

# EXHIBIT B

Docket No.: **11590/9-1268**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Applicant: Leonard E. Marchese

Conf. No. 1815

Serial No.: 09/613,980

Group Art Unit: 2151

Filed : July 11, 2000

Examiner: Khanh Q Dinh

For : ELECTRONIC SPACE AND METHOD FOR  
FACILITATING PROBLEM SOLVING

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Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed on September 14, 2007, the applicant encloses a replacement paper supplying the Summary of the Claimed Subject Matter. Per MPEP 1205.03(B), an entire new brief is not needed, there being no other stated objections in the notice of non-compliance.

The applicant hereby objects to the notice of non-compliance as being improper and untimely. While the refused brief was submitted on January 26, 2006, this was a reinstatement of the appeal, and there was no indication that the original appeal brief submitted on May 4, 2005, having a virtually identical Summary of the Claimed Invention, was non-compliant. Even without the prior review, it should not have taken nearly two years to look at the brief and decide that the brief was non-compliant.

The Summary provided was certainly adequate and should have been accepted, as it did describe the critical elements of the independent claims, with reference to the specification. Alternatively, from the delay alone, it should be considered that any objections as to form were waived.



This case has been before the Patent Office for over 7 years. It is over two years since the first brief was filed. It is requested that this application receive expedited consideration, and that further delays be avoided.

The required fee for filing the Appeal Brief was paid with submission of the first Appeal Brief on May 4, 2005. No fee is believed to be due at this time, however, should any fee be due, the Commissioner is authorized to charge any deficiency or credit any excess to Deposit Account No. 04-0838.

Dated: September 28, 2007

Respectfully submitted,

\_\_\_\_\_/WJS/\_\_\_\_\_  
William J. Sapone  
Registration No. 32,518  
Attorney for Applicant(s)

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## **SUMMARY OF CLAIMED SUBJECT MATTER**

The invention is directed to a system for organizing and assembling information and resources for interaction with at least one user for facilitating creative problem solving is shown in Fig. 1, the system (1) including a host/server (2) disposed on a network (p. 5, l. 15-16) (Claim 21, 32). Storage is provided to save the user configuration on the host/server, though storage on user devices is also contemplated.(p. 5, l. 21-p. 6, l. 3) (Claim 21)

A plurality of devices, such as the personal computer 3 or laptop computer 5 are connectable to the host/server. The host/server contains the software that acts as the means for generating a plurality of user configurable electronic spaces (4, 8, 6, 9 and 11) (P. 5, l. 15-p. 6, l.3; p20, l. 9-11).(Claim 21, 32) A user configured electronic space is configured by the user to look like a room (12) with furnishings and decorations (see Fig. 2) containing a plurality of images that also function as links to various resources and applications. (p. 7, l. 11-19).(Claims 21, 26 and 32)

Each user may access the electronic space by means of various electronic devices, such as the PC (3), laptop (5) or a mobile wireless device (7), and then may select specific icon images such as the phone (14) to activate one of a selection of communication links or engage the typewriter icon ( 15) to use a word processing application (p. 7, l. 13-17)(Claim 21, 26 and 32)

The electronic room space, best shown in applicant's Fig. 2, is not a conventional user interface. The room image is configured by the user to contain personalized iconic images representative of the tastes of the user, and which also act as interactive user configured links to selected resources. The links enable the user to interact with selected resources, to gather further resources and to interact with selected individuals, providing a unique workplace

conducive to problem solving.

Fig. 3 illustrates the multidimensional interaction available to a user of the applicant's invention. A user configured virtual room has selected "decorations" and "furnishings" that actually link to specific resources so the user can literally work within the "room" on problem solving. Each member of a group working on the same problem has their own room, so each can interact not only with their selected resources but also with each other in a common electronic space or "meeting room". Thus, the electronic space is a dynamic environment for the user, not merely a man-machine interface.

Each of independent claims 21, 26 and 32 also incorporate an intelligent agent application, and means to engage a dispatcher in locating resources and tools to assist the user. (p. 5, l. 3-7; p.10, l.15-18; p.14, l.20 - p.15, l.5; p. 17, l. 8-12). The user also has a system monitor to oversee and work in concert with the intelligent agent (p. 5, l. 3-7), and which may also function as a dispatcher for locating resources on request, providing tools for creating reports, graphics, letters, presentations, access to an AI based system for morphing solutions, etc. (p.14, l. 20 - p. 15, l.5). The dispatcher may also locate experts or relevant databases, or technical resources, to facilitate the problem solving process. (p.17, l. 8-12). Utilizing the intelligent agent and dispatcher, a user can increase the speed at which a solution is arrived at, and can develop solutions that would be difficult to arrive at in a standard office setting.